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PATENT APPLICATION

ATTORNEY DOCKET NO. 10004124-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Gary D. Sasaki et al.

Confirmation No.: 7533

Application No.: 09/741,725

Examiner: Sherr, Cristina

Filing Date: Dec. 19, 2000

Group Art Unit: 3621

Title: DISTRIBUTING DIGITAL CONTENT

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Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

(X) Response/Amendment
( ) New fee as calculated below
(X) No additional fee
( ) Other: _____ (fee $_____)

( ) Petition to extend time to respond
( ) Supplemental Declaration

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	30	MINUS	30	= 0	X $50	$ 0
INDEP. CLAIMS	2	MINUS	3	= 0	X $200	$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ $360	$ 0
EXTENSION FEE	1ST MONTH $120.00 [X]	2ND MONTH $450.00 [ ]	3RD MONTH $1020.00 [ ]	4TH MONTH $1590.00 [ ]		$ 120
					OTHER FEES	$
					TOTAL ADDITIONAL FEE FOR THIS AMENDMENT	$ 120

Charge $ 120 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Date of Deposit: **June 15, 2005**

Typed Name: **Edouard Garcia**

Signature: _____

Respectfully submitted,

Gary D. Sasaki et al.

By _____

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3621
TRW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Gary D. Sasaki et al.
Serial No. : 09/741,725
Filed : December 19, 2000
Title : DISTRIBUTING DIGITAL CONTENT

Art Unit : 3621
Examiner : Sherr, Cristina O.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO THE EXAMINER'S ACTION DATED MARCH 9, 2005

I. Status of claims

Claims 1-30 are pending.

II. Claim rejections

The Examiner has rejected claims 1-30 under 35 U.S.C. § 103(a) over Khan (U.S. 6,401,206) in view of Makipaa (U.S. 6,394,341).

For the purpose of the following discussion, the Examiner is reminded that (emphasis added):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not on applicants' disclosure.

CERTIFICATE OF MAILING

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June 15, 2005
Date

(Signature of person mailing papers)

Edouard Garcia
(Typed or printed name of person mailing papers)

MPEP § 706.02(j). Furthermore, as pointed out by the Patent Office Board of Appeals and Interferences:

> The examiner should be aware that "deeming" does not discharge [her] from the burden of providing the requisite factual basis and establishing the requisite motivation to support a conclusion of obviousness.

Ex parte Stern, 13 USPQ2d 1379 (BPAI 1989).

A. Claims 1-11 and 21-27

Claim 1 is an independent claim and claims 2-11 and 21-30 depend from claim 1.

1. Independent claim 1

Claim 1 recites:

> Claim 1 (previously presented): A portable media device, comprising:
> a memory configured to store digital content;
> a wireless transceiver configured to wirelessly transmit and receive digital content;
> an output configured to render digital content; and
> a controller coupled to the memory, the wireless transceiver and the output, the controller being configured to authorize wireless transmission of a transfer file to a third party device in accordance with meta-data associated with a particular digital content and without regard to any identifier of the third party device, the transfer file including meta-data containing permissions information restricting rendering of the particular digital content by the third party device.

The Examiner has asserted that on col. 3, line 65, through col. 4, line 65, Khan discloses all of the elements recited in claim 1, except that "Khan does not disclose, but Makipaa does, a portable media device such that playback may take place virtually anywhere (e.g., col 3 ln 65 – col 2 ln 45)."

a. The Examiner has failed to establish a proper *prima facie* case of obviousness

As shown by the following detailed analysis, the cited section of Khan does not support the Examiner's assertion that Khan teaches all of the elements recited in claim 1 except that these features are part of a portable media device. In fact, the cited section of Khan does not disclose any of the features recited in claim 1.

Location in Khan's Disclosure (col./line numbers)	Quoted Text of Khan's Disclosure	Analysis
Col. 3, line 65 – col. 4, line 9	The present invention creates a digital identity of an individual that can be used in electronic authentication systems for signing the electronic documents. This identity typically includes personal information, images, handwritten signature and passwords. It optionally includes seals, fingerprints and other biometric information. This digital identity can be used to authenticate the integrity and identity of an electronic document, as well as for non-repudiation of the electronic document's origination source. The digital identity also has other properties associated with conventional electronic authentication systems.	No teaching or suggestion of any of the features recited in claim 1.
Col. 4, lines 10-18	Forgeries of the digital identity, attacks against it, and repudiation of use of the digital identity can be detected by use of an identifier computed from personal information provided by the user. Passwords can be used as one component of this personal information. Using the digital identifier enables forgeries to be detected and repudiation of origin to rebuffed, even if the public key cryptographic assumption is broken. Some versions of the digital identifier can also be reconstructed in case the original digital identity is lost.	No teaching or suggestion of any of the features recited in claim 1.
Col. 4, lines 19-23	This digital identity can be used in automatic verification systems because it provides consistent results, unlike handwritten signature systems in which the comparison results for two signatures may vary significantly, leading to unreliable results.	No teaching or suggestion of any of the features recited in claim 1.
Col. 4, lines 24-30	Although the digital identity may contain handwritten signatures, images, seals, fingerprints and other biometric information in digitized or parameterized form, the authentication and verification process associated with the digital identity does not solely depend on these components. Neither does the security depend only on cryptographic keys or difficult-to-remember passwords.	No teaching or suggestion of any of the features recited in claim 1.

Col. 4, lines 31-35	Since the use of parameterized signature, fingerprints, photographic images and biometric information is optional, the present invention does not depend on sophisticated technology that is not readily available to an ordinary computer user.	No teaching or suggestion of any of the features recited in claim 1.
Col. 4, lines 36-44	The digital identity generated in accordance with the present invention is portable, such as in a floppy disk, smart card, memory card, or other storage device. A compromised storage device is useless, because the digital identity information on it is encrypted. Furthermore, the verifier does not need to know or maintain a document signer's sensitive information to perform verification. As a result, the verifier can be a non-trusted party who does not have to know the private information or parameters associated with the identity of the signer.	No teaching or suggestion of any of the features recited in claim 1.
Col. 4, lines 45-63	Electronically signing a document is a cumbersome process, especially when it contains a variety of representations of the signer such as handwritten signatures, photographic images and biometric information. Hence in one embodiment of the invention, the digital identity of the signer is created once and stored after encryption for protection. This identity can be used with little effort to bind a verifiable impression made by the signer's identity to any document. A series of techniques can be used for the person's identity verification. First the cryptographic digital signature is verified which establishes the integrity of the document, and ensures non-repudiation of origin to the extent that it was signed by the holder of the private key. A time stamp or random number is used to establish that the document is not a duplicate presented as an original. In case of a dispute, digital identity marks, which are functions of the document and the personal identifiers, are used to verify that the digital signature indeed made the signature impression on the accompanying document.	No teaching or suggestion of any of the features recited in claim 1.

Thus, contrary to the Examiner's assertion, the cited section of Thomson does not disclose any of the features recited in claim 1.

As shown by the following detailed analysis, the cited section (i.e., col. 1, line 50 through col. 2, line 45) of Makipaa does not support the Examiner's assertion that Makipaa teaches a portable media device such that playback may take place virtually anywhere. In fact, the cited section of Makipaa does not disclose anything about a portable media device such that playback may take place virtually anywhere.

Location in Makipaa's Disclosure (col./line numbers)	Quoted Text of Makipaa's Disclosure	Analysis
Col. 1, line 50 – col. 2, line 12	The present invention is a system and method for collecting data pertaining to financial transactions provided by a transaction provider which may be any form of commercial establishment, such as a point of sale for the purchase of goods or services or an entity providing electronic commerce, such as the purchase of goods or services over an IP network. The information which is collected with the present invention is utilized for business and personal accounting and financial management. The collected information includes at least an electronic receipt of the financial transaction but may also contain additional information which is stored by a user information system for facilitating business and personal accounting and financial management functions to the user. The user device communicates with the transaction provider selections of financial transactions made by the user of the user device which are offered by the user provider and information permitting the transaction provider to verify that the electronic receipt has been accepted by the user of the user device. The user information system communicates with at least one of the transaction provider or the user device and stores at least the electronic receipt which is received from the user device or the transaction provider which is verified by the user information system to have been accepted by the user of the user device. As a result of storage of at least the verified electronic receipt, the user information system becomes either a personal or business database which stores detailed information about the contents of the transaction and the individual items included in the transaction such as that which is typically recorded on a paper receipt.	No teaching or suggestion of anything about a portable media device such that playback may take place virtually anywhere.
Col. 2, lines 13-21	The invention provides diverse benefits to users of the user device, transaction providers and intermediate service providers for developing business associated with the financial transaction. Examples are: customer buying information management, product buying information management, customer profile management, loyalty management, user information marketing, personal	No teaching or suggestion of anything about a portable media device such that playback may take place virtually anywhere.

	financial management, professional financial management and price tracking as described below.	
Col. 2, lines 22-42	The user information system eliminates the laborious process of collecting financial information from analysis of paper receipts. The information, including the electronic receipt which is stored by the user information system after verification, is a complete description of the financial transaction and is unlike the limited summary of information provided with a smart, credit or debit card billing statement. Instead of what amounts to a summary of each purchase which is included in a monthly statement of a smart, credit or debit card which is centered upon only the total amount of the purchase, the present invention collects substantial information about the details of each financial transaction, including an electronic receipt, any involved intermediate service provider, such as a bank or other financial institution from which smart, credit or debit services were obtained, including the identification of any accounts used for the financial transactions, the location from which the goods or services was purchased and the individual who entered into a financial transaction in a situation in which the user information system is providing storage of organizational information.	No teaching or suggestion of anything about a portable media device such that playback may take place virtually anywhere.
Col. 2, lines 43-45	The information stored by the user information system records communications between a user of the user device and the transaction provider.	No teaching or suggestion of anything about a portable media device such that playback may take place virtually anywhere.

To summarize, Khan fails teach or suggest any of the features recited in claim 1 and Makipaa does not make-up for this failure. For example, neither Khan nor Makipaa teaches or suggests a portable media device that has a controller that is configured to authorize wireless transmission of a transfer file to a third party device in accordance with meta-data associated with a particular digital content and without regard to any identifier of the third party device, where the transfer file includes meta-data containing permissions information restricting rendering of the particular digital content by the third party device. Since neither of the cited references teaches or suggests such a feature, no possible combination of the cited references could teach or suggest such a feature. Accordingly, the Examiner has failed to

establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103 and the rejection of claim 1 should be withdrawn.

In addition, the Examiner has not provided any explanation whatsoever as to why and how one having ordinary skill in the art at the time the current invention was made would have been motivated to modify the teachings of Khan based on the teachings of Makipaa to arrive at the invention recited in claim 1. The Examiner has failed to point to any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings, as required for a proper rejection under 35 U.S.C. § 103 (see MPEP § 706.02(j), quote above). Without a proper explanation for combining these references, the Examiner again has failed to establish a proper *prima facie* case for obviousness under 35 U.S.C. § 103 and the rejection of claim 1 should be withdrawn.

b. In any event, claim 1 is not obvious over Thomson in view of Audible

Khan discloses a system and a method for creating a portable digital identity of a person that can be used to bind a verifiable electronic impression with an electronic document using electronic watermarks so that any modification in the document or the electronic impression bound to the document can be detected. Makipaa discloses a system and a method for collecting financial transaction data.

Neither Khan nor Makipaa teaches or suggests anything that would have led one of ordinary skill in the art at the time the invention was made to the inventive portable media device that is recited in independent claim 1. For example, neither Khan nor Makipaa teaches or suggests a portable media device that has a wireless transceiver configured to wirelessly transmit digital content and a controller that is configured to authorize wireless transmission of a transfer file to a third party device in accordance with meta-data associated with a particular digital content and without regard to any identifier of the third party device, where the transfer file includes meta-data containing permissions information restricting rendering of the particular digital content by the third party device. Therefore, no possible combination of Khan and Makipaa could possibly teach or suggest such a portable media device.

For at least these additional reasons, the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a) over Khan and Makipaa should be withdrawn.

2. Claims 2-11 and 21-30

Each of claims 2-11 and 21-30 incorporates the features of independent claim 1 and therefore is patentable for at least the same reasons explained above.

Regarding claim 2, the Examiner has asserted that "Khan discloses a device wherein the controller is configured to control playback of digital content stored in the memory based upon a user license confirmation (e.g., col 4 ln 20-65)." Contrary to the Examiner's assertion, however, the cited section of Khan's disclosure does not teach or suggest anything about controlling playback of digital content.

The Examiner also has made a number of assertions regarding the contents of Khan's disclosure relating to claims 3-11. None of these assertions, however, is supported by Khan's disclosure.

B. Claims 12-20

Claim 12 is an independent claim and claims 13-20 depend from claim 12.

Independent claim 12 recites that each of the portable media devices includes features of the portable media device recited in independent claim 1, including a controller that is configured to authorize wireless transmission of a transfer file to a third party device without regard to any identifier of the third party device.

Claim 12, therefore, is patentable for at least the same reasons explained above in connection with independent claim 1, and the Examiner's rejection of independent claim 12 under 35 U.S.C. § 103(a) over Khan in view of Makipaa now should be withdrawn.

Each of claims 13-20 incorporates the features of independent claim 12 and therefore is patentable over Khan and Makipaa for at least the same reasons.

III. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

Date: June 15, 2005

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